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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,410	11/28/2000	Satoru Okada	723-951	4624
27562	7590	08/05/2005		
NIXON & VANDERHYE, P.C. 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER MOSSER, ROBERT E	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/722,410	<b>Applicant(s)</b> OKADA ET AL.	
	<b>Examiner</b> Robert Mosser	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.  
 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 140--152, 166--169, 171--182, 184--195, 201-251 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 140, 166-169, 201-207, 220-222, 235-237, 250 and 251 is/are rejected.  
 7) ☒ Claim(s) 141-152, 171-182, 184-195, 208-219, 223-234 and 238-249 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-8-2005</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**



**The 1449 submitted 8-10-2004 has been reviewed and is attached for applicant's records.**

**This action is non-final.**



***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **202-203, 205-206, 220-221, 235-236, and 250-251** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims **202, 205, 220, 235, and 250** contains the trademark/trade name Palm.

Claims **203, 206, 221, 236, and 251** contains the trademark/trade name Windows.

Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods

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associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a wide family of operating system program products, which have evolved and will continued to do so for the foreseeable future and, accordingly, the identification/description is indefinite.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **140, 166-169, 201, 204, 207, 222, and 237**, are rejected under 35 U.S.C. 103(a) as being unpatentable over The Game Boy Programming Manual (c) 1999.

Claim **140** is considered representative of claims **166-169**, and the base features of claims **201, 204, 207, 222, 237**.

The Game Boy handheld system with user-manipulable control (page 12) includes three distinct memory portions equated to a object attribute memory (OAM), a color palette memory, and a video memory (Page 20, "OAM RAM", "Palette RAM"; Page 12 "Display RAM). The system further includes bitmap/character (Page 47-51) memory for the transfer of bitmap/character data to a display memory responsive to the actions of a user (Page 31) and displaying the contents of the display memory on a display (Pages 51-54, and 71).

[Memory Address Ranges]

Though the claimed memory address ranges do not correlate to those presented in the prior art the absence of defined structure or a defined function relationship with relation to the provided memory addresses as set forth in the instant claims equates these memory ranges to a matter of nomenclature or design choice. One would not be reasonably appraised from the claim language alone that a memory space from 05000000h to 050003FFh would include a fixed amount of bit storage or even the location of said particular storage in relation to the remaining specified storage (memory).

For example if one were to equate the claimed memory addresses to indices within a paper book, the section addressing OAM could be assigned within lines 5-185. In this example however, without defining before hand in which volume, chapter, or pages on which the line numbers are present they could very well be located at any portion in the book. In relation to this though the claims are interpreted in view the applicant's specification they are not limited by the specification and as such though the

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specification may demonstrate memory configurations such as the one shown in figure 16 of the instant application the presented claims are not limited to such an interpretation.

It would have been obvious to one of ordinary skill in the art to readdress the memory ranges of Game Boy Programming Manual (c) 1999 as provided above in order to create a product that contained fixed addressed memory regions regardless of actual memory size across future upgrades.

[Storing no more than...]

The limitations directed to the storing no more than a certain amount of information in a given portion of memory at anyone time are so broad as to include the storing nothing to a given memory location. Under this interpretation storing zero 48-bit moving object definitions is well encompassed as any memory such as the one provided by the prior art above could at the very least store zero of a particular data element.

Claims **201, 204, 207, 222, and 237** address the inclusion of an emulator in addition to the above wherein a first system emulates second system with preceding features. For the purposes of this rejection the office interprets the first system as a Game Boy system (Super Game Boy page 3) and the second system as another Game Boy system (Super Game Boy page 3). In this interpretation either unit would serve as the perfect emulator for the other meeting the claim language as presented. Further

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though not directly addressed in this rejection it is understood that the later versions of the Game Boy including the Game Boy Color were capable of executing Games originally intended for the original 1989 release of the Game Boy monochrome.

***Allowable Subject Matter***

Claims **141-152, 171-182, 184-195, 208-219, 223-234, and 238-249** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***References Filed Under Seal***

The office has received the References filed under Seal and has begun the process of their consideration with regards to the instant application however, as of this time the determination of applicability has not been completed with regards to the SNES Development Manual. The reference filed under seal and entitled Game Boy Programming manual has been utilized in the rejection above and additionally cited on the attached 892.

***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a horizontal line.

JESSICA HARRISON  
PRIMARY EXAMINER